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U.S. Application No. 10/801,222 Examiner Gauthier, Art Unit 2614
RCE in Response to December 21, 2006 Final Office Action

REMARKS

In response to the final Office Action dated December 21, 2006, the Assignee respectfully requests continued examination and reconsideration based on the above amendments and on the following remarks.

Claims 1-21 are pending in this application.

The United States Patent and Trademark Office (the "Office") rejected claim 21 under 35 U.S.C. § 101 for claiming non-statutory subject matter. Claims 1-21 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,310,944 to Brisebois *et al.*

The pending claims, however, are not anticipated. As the following paragraphs explain, the pending claims all recite features that are not taught or suggested by *Brisebois*. The § 102 (e) rejection, therefore, must be withdrawn.

Rejection of Claim 21 under § 101

Claim 21 was rejected under 35 U.S.C. § 101 for claiming non-statutory subject matter. Claim 21, however, has been amended to recite a "computer program product comprising processor-executable instructions." Claim 21 thus recites the same features as independent claims 14 and 20. The Assignee thus respectfully asserts that claim 21 fully complies with the patent laws.

Rejection of Claims 1-13 under 35 U.S.C. § 102

The Office rejects claims 1-13 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,310,944 to Brisebois *et al.* A claim, however, is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also*

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DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Claims 1-13 cannot be anticipated. Claims 1-13 recite, or incorporate, features that are not taught or suggested by *Brisebois*. Independent claim 1, from which claims 2-13 depend, recites "allowing a subscriber to select a text message from a library of pre-created text messages." Support for such features may be found at least in the as-filed application at paragraph [0031]. Examiner Gauthier is correct — *Brisebois* describes a text message that may be sent to a called party. See, e.g., U.S. Patent 6,310,944 to *Brisebois et al.* (Oct. 30, 2001) at column 4, lines 31-35. *Brisebois* also describes a text message that may be sent to the calling party. See *id.* at column 7, lines 13-15. Yet no where does *Brisebois* describe "allowing a subscriber to select a text message from a library of pre-created text messages." Because *Brisebois* is silent to this claimed feature, the patent to *Brisebois et al.* cannot anticipate claims 1-13.

Moreover, claims 1-13 recite, or incorporate, additional distinguishing features. Independent claim 1, for example, recites "allowing the subscriber to associate the text message to multiple originating parties and to groups of multiple recipients." Support for such features may be found at least in the as-filed application at paragraph [0031]. When a call is received from an originating party, then the text message is communicated "to a group of multiple recipients via an Internet Protocol communications network." Again, *Brisebois* describes a text message that may be sent to the calling party or to the called party. No where, however, does *Brisebois* describe "multiple originating parties" and "groups of multiple recipients." Because *Brisebois* is silent to these claimed features, the patent to *Brisebois et al.* cannot anticipate claims 1-13.

Claims 1-13, then, cannot be anticipated. Claims 1-13 recite, or incorporate, many features that are not taught or suggested by *Brisebois*. The Assignee thus respectfully requests removal of the § 102 rejection of claims 1-13.

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Rejection of Claims 14-21 under 35 U.S.C. § 102

The Office also rejected claims 14-21 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,310,944 to Brisebois *et al.* Yet *Brisebois* cannot anticipate these claims. Independent claims 14, 20, and 21 already recite features that are not taught or suggested by *Brisebois*. Independent claims 14, 20, and 21 similarly recite “allowing a first party to compose a data message and to associate that data message with a second party and with a third party.” No where does *Brisebois* make any description of “context information” being associated with three (3) different parties. Examiner Gauthier is correct — *Brisebois* describes a “subscriber,” a “calling party,” and a “called party.” As the Assignee has previously explained, though, *Brisebois* uses the term “subscriber” interchangeably with “calling party” or with “called party,” depending on the example. Because the patent to *Brisebois et al.* is completely silent to the claimed three-party communications service, *Brisebois* cannot anticipate claims 14-21. The § 102 rejection must, therefore, be withdrawn.

Brisebois provides many examples. Suppose “the calling party on Global System for Mobility (“GSM”) handset 33 places a call to the called party on ADSI phone 30.” U.S. Patent 6,310,944 to *Brisebois et al.* (Oct. 30, 2001) at column 6, lines 58-61 (emphasis added). “The GSM network 34 identifies the GSM handset 33 with the name and number of the subscriber, along with GPS coordinates or the cell ID.” *Id.* at column 6, lines 61-63 (emphasis added). “Server 32 identifies the called party as an ADSI call context subscriber.” *Id.* at column 6, lines 65-66 (emphasis added). In this example, then, the “called party” and the “subscriber” are the same person.

Brisebois provides another example. *Brisebois* explains how the “called party” may again be a “subscriber” to context information:

For automatic creation of called party context information, suppose the called party is on GSM handset 33 and is a subscriber to the call context feature. The calling party places a call to GSM handset 33 on ADSI phone 30 through PSTN 31. Server 32 requests the name of the called party, along with GPS coordinate or the cell ID, from GSM network 34. GSM network 34

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provides this information to server 32 which, in turn, sends the information to ADSI phone 30 as a text-based message. Using this information, the calling party indicates to server 32 whether he wishes to complete the call by, for example, selecting an appropriate soft-key. If the calling party wishes to complete the call, server 32 would place a call request to GSM network 34, and the call would complete as usual.

Id. at column 7, lines 7-20 (emphasis added).

Brisebois provides still another example. *Brisebois* explains how the "calling party" may again be a "subscriber" to context information:

In the case of standard options creation for calling party context information, suppose that the calling party, on ADSI phone 30, has subscribed to the call context feature from the local service provider. Using the ADSI protocol, server 32 loads a call context service script into the subscriber's ADSI phone 30 via PSTN 31. When the calling party goes off-hook, the call context options appear as soft-keys. Suppose the calling party initiates a call to a called party on GSM handset 33. The calling party could select a soft-key indicating that he desired a voice connection with the called party. Server 32 sends this short message along with the call request information over PSTN 31 to GSM network 34. The called party receives the standard call request information from GSM network 34, along with the context message.

U.S. Patent 6,310,944 to Brisebois *et al.* (Oct. 30, 2001) at column 7, lines 21-34 (emphasis added).

Brisebois provides yet another example. *Brisebois* explains how the "called party" may again be a "subscriber" to context information:

Similarly, for standard options creation for called party identification, suppose the called party, on GSM handset 33, is a subscriber to the call context feature. At an earlier time, the called party, using menu options or star commands, could select various options that would be stored on server 32. For example, the called party could select an option indicating that he can receive only voice communications. When the calling party, on ADSI phone 30, places a call to GSM handset 33, server 32 recognizes the called party as a subscriber to the call context feature and provides the pre-selected context information to ADSI phone 30 via PSTN 31. Based

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on this information, the calling party indicates to server 32 whether to complete the call by using, for example, soft-keys on ADSI phone 30.

Id. at column 7, lines 35-48 (emphasis added).

The Assignee must, very respectfully, disagree with Examiner Gauthier. Examiner Gauthier cites column 6, lines 11-22 of *Brisebois* as teaching “allowing a first party to compose a data message and to associate that data message with a second party and with a third party.” These passages of *Brisebois* describe custom disposition options “based on the identify of the calling party.” U.S. Patent 6,310,944 to *Brisebois et al.* (Oct. 30, 2001) at column 6, lines 14-16. Yet *Brisebois* goes on to explain that once “the network has gathered context information from one or more of the above-described sources, **it transmits the context information to the calling party.**” *Id.* at column 6, lines 31-33 (emphasis added). The patent to *Brisebois et al.* merely describes a communication associated with two parties (e.g., the calling party and the called party). *Brisebois*, then, fails to disclose a communications service that “allow[s] a first party to compose a data message and to associate that data message with a second party and with a third party” (as independent claims 14, 20, and 21 recite).

Claims 14-21, then, cannot be anticipated. Claims 14-21 recite, or incorporate, many features that are not taught or suggested by *Brisebois*. The Assignee thus respectfully requests removal of the § 102 rejection of claims 14-21.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Scott P. Zimmerman", is written over a horizontal line.

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